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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,017	11/22/2000	Winnie C. Durbin	GEMS8081.023	5745
27061	7590	01/11/2008		
ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (GEMS)				
136 S WISCONSIN ST				
PORT WASHINGTON, WI 53074				
			EXAMINER	
			HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER
			3621	
			NOTIFICATION DATE	DELIVERY MODE
			01/11/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/681,017

Applicant(s)

DURBIN ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-26 have been examined.

Response to Amendments/Arguments

2. Applicant's Affidavit filed on 26 March 2007 is not sufficient to overcome the rejection to claims 1-26 as the Applicant has not established diligence (37 CFR 1.131).

Claim Rejections - 35 USC § 103

3. Claims 1-7, 10-18, and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neville et al., U.S. Patent No. 6,272,636 in view of Leovac, U.S. Patent No. 6,668,375.

As per claims 1-3, 23, and 24, Neville et al. teach a sending a request/user ID to a server/clearinghouse (i.e. facility) ('636, column 13, lines 17-20) ("receiving a user ID at a facility from a user"). The request/user ID acts as a request, from a client to the server/clearinghouse, for a key to unlock locked software ('636, column 13, lines 25-27) (receiving a software request from the user specifying software to be enabled in equipment at a subscribing station). Neville et al. also teach "at a centralized facility, confirming that the software has

not already been enabled because the server/clearinghouse determines whether or not the user is eligible to receive the unlock key ('636, column 13, lines 30-35). And if, the user is eligible to receive the unlock key, the user receives the key from the user and unlocks the software. Regarding the "confirming" step, the server/clearinghouse initially receives a request from a user ('636, column 13, lines 57-59). This is the first indication that the user is not using the software, otherwise, the user would not have a reason, in light of the teachings of Neville et al., to request an unlock key. The "confirmation" comes from the server/clearinghouse checking a use history database to confirm whether this is so ('636, column 13, lines 30-35; column/line 13/60-14/3). Neville et al. also teach a software key to enable software previously installed equipment (column/line 13/13-14/15). In the Board's Decision (2006-0490), the Board defined an option as "an item that is offered in addition to or in place of standard equipment" Webster's New Collegiate Dictionary (G. & C. Merriam Co. 1977). Therefore, to one of ordinary skill "standard equipment" is the user computer (column 10, lines 61-65; column 13, lines 54-55) or the user computer with a disabled or limited version of the software (column 2, lines 12-27). While in both cases, the fully functional version of the software (column/line 16/46-17/5) is the "item that is offered in addition" to the standard equipment. Nonetheless, Leovac teaches a method where a user can enable previously disabled options (where "option" is defined as "an item that is offered in addition to or in place of standard

equipment”, Webster’s New Collegiate Dictionary (G. & C. Merriam Co. 1977)) in software by requesting a key from a remote center, wherein the key is generated at the center, specific to a user’s system, and transmitted to the user over the internet (figure 2, items 13 and 17; column 3, lines 15-52; column 4, lines 5-22). Leovac also teaches determining options already in place on a user’s system (column 3, lines 25-34) Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Neville et al. and Leovac in order ensure that payment is received for options enabled after installation (‘375, column 1, lines 13-37).

As per claims 4, 5, 15, and 25, Neville et al. generally teach a system for executing software on a remote processor (abstract; column/line 10/62-11/5; column 12, lines 48-52). Neville doesn’t explicitly recite a client system as a medical imaging scanner. However, an “end-user computer” (column 10, lines 62-67) is elastic enough to encompass any device that “accepts structured input, processes it according to prescribed rules, and produces the results as output.” Regarding claims 5 and 25, Neville et al. specifically recite “try before you buy”, and “crippled” software distribution models (column 2, lines 11-47), therefore, it would have been obvious to one of ordinary skill to use the secure product execution method of Neville et al. to activate trial options or features (column/line 13/13-14/15).

As per claims 6, 7 and 26, both Neville et al. ('636, column/line 13/13-14/15) and Leovac ('375, column 3, lines 35-38) teach authenticating a user ID and downloading the enabling feature automatically, while Neville et al. teach downloading without further user input (column/line 13/13-14/15).

As per claims 10-14 and 16-18, Neville et al. teach validating an options request, creating an option key in response thereto, a communications network for relaying data, and transmitting the option key through an external communications network (figures 8 and 9; column 10, lines 62-65; column/line 13/13-14/15). Neville et al. generally teach a system for executing software on a remote processor (abstract; column/line 10/62-11/5; column 12, lines 48-52). Neville doesn't explicitly recite a client system as a medical imaging scanner. However, an "end-user computer" (column 10, lines 62-67) is elastic enough to encompass any device that "accepts structured input, processes it according to prescribed rules, and produces the results as output." Neville et al. also teach receiving and validating a user ID/system ID, receiving an option request from a user and invalidating a user ID/system ID (column 13, lines 20-35), comparing the request against other requests (column 13, lines 20-25 and 60-67) and "try before you buy" and "crippled" software distribution models (column 2, lines 11-47). Regarding "trial software", Neville et al. recite evaluation periods based on a number of executions or time periods (column 13, lines 60-67) and tracking the number of user requests for a digital product (column 13, lines 20-25). However,

Neville et al. do not specifically recite generating an option key in response to a user request. Leovac teaches a method and system for securely distributing software comprising the generation of an option key in response to a user request (figure 2, items 13 and 17). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Neville et al. and Leovac in order to prevent the uncontrolled distribution of software ('375, column 3, lines 34-64).

4. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neville et al., U.S. Patent No. 6,272,636 and Leovac, U.S. Patent No. 6,668,375, as applied to claim 1 above, and in further view of, Linden et al., U.S. Patent No. 6,360,254.

As per claims 8 and 9, Neville et al. teach a system for enabling software in a computer (abstract). Leovac teaches a method where a user can enable previously disabled options in software by requesting a key from a remote center, wherein the key is generated at the center specific to a user's system and transmitted to the user over the internet (figure 2, items 13 and 17; column 3, lines 15-52; column 4, lines 5-22). However, neither Neville et al. nor Leovac specifically recite sending enabling features by e-mail and electronic confirmation of the option enablement. Linden et al. teach a secure method for enabling a remote computer to access a resource comprising sending an enabling feature

by e-mail and sending a verification e-mail to the user confirming option enablement (column 11, lines 28-39). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Neville et al., Leovac and Linden et al. in order to distribute the key efficiently ('636, column 10, lines 62-65; '375, figure 2, items 13 and 17) and in a manner that is familiar to the user such as via e-mail ('254, column 11, lines 28-39).

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neville et al., U.S. Patent No. 6,272,636 and Leovac, U.S. Patent No. 6,668,375 as applied to claim 18 and in further view of Ernest, U.S. Patent No. 4,888,798.

As per claim 19, Neville et al. teach a client transmitting to a server (that is connected to a plurality of clients) a user ID/system ID for authentication with an option enabling request, comparing the request against other requests and the server distributing software keys over a communications network to the client for enabling software options in response to the client's transmission (abstract; column/line 13/13-14/15). Neville et al. also disclose "try before you buy" and "crippled" software distribution models (column 2, lines 11-47). Leovac teaches a method and system for securely distributing software comprising the generation of an option key in response to a user request (figure 2, items 13 and 17). However, neither Neville et al. nor Leovac specifically recite a software key with a disablement feature. Ernest teaches a system for securing distributed software

using software keys, with a predetermined time based disablement option, to unlock specific features (column/line 14/66-15/30). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Neville et al., Leovac and Ernest in order more securely control trial period software ('676 abstract).

6. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neville et al., U.S. Patent No. 6,272,636 and Leovac, U.S. Patent No. 6,668,375 as applied to claim 18 above, and in further view of Oki et al., U.S. Patent No. 6,115,471.

As per claims 20-22, Neville et al. teach a client transmitting to a server (that is connected to a plurality of clients) a user ID/system ID for authentication with an option enabling request, comparing the request against other requests and the server distributing software keys over a communications network to the client for enabling software options in response to the client's transmission (abstract; column/line 13/13-14/15). Leovac teaches a method and system for securely distributing software comprising the generation of an option key in response to a user request (figure 2, items 13 and 17). However, neither Neville et al. nor Leovac specifically recite authenticating a user ID prior to receiving a request and system ID. Oki et al. teach a software distribution system comprising authenticating a user ID, prior to receiving an option enabling request and

receiving then authenticating a system ID (column/line 7/55-8/11). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Neville et al., Leovac and Oki et al. in order to prevent illegal copying of software ('471, column 8, lines 1-5).

Conclusion

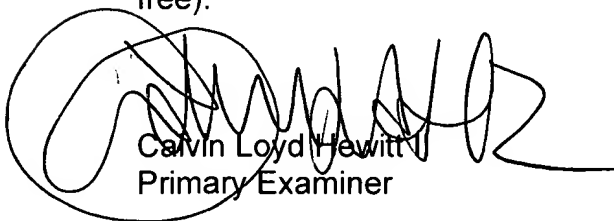
7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Calvin Loyd Hewitt II
Primary Examiner

December 31, 2007